

**Remarks/Arguments:**

Claims 34-35, 38, 40-45, 58-59, 61, and 63-68 are canceled without prejudice. Claims 32 and 69 are amended. Support for the amendments can be found, e.g., at page 18, line 25 – page 19, line 20 and page 25, line 28 – page 28, line 6 of the specification. No new matter is introduced.

Claims 32, 36, 55, 60, and 69-71 are pending in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

**CLAIM REJECTIONS UNDER 35 USC § 112 – WRITTEN DESCRIPTION – NEW MATTER**

Claims 32, 34-36, 38, 40-45, 55, 58-61, and 63-71 are rejected for failing to comply with the written description requirement. More specifically, the Examiner stated that the added limitation “used by the cell or organism as a template to generate small gene-silencing effectors” is new matter because it is not supported by the specification as filed. See the Office Action, page 3, first paragraph – page 4, first paragraph.

Without acquiescence in the Examiner’s rejections and for the sole purpose of moving the prosecution of this application forward, Applicants have deleted the rejected limitation from claims 32 and 69. Applicants thus respectfully submit that the rejections have been overcome and should be withdrawn.

**CLAIM REJECTIONS UNDER 35 USC § 112 – ENABLEMENT**

Claims 32, 34-36, 38, 40-45, 55, 58-61, and 63-71 are rejected for failing to comply with the enablement requirement. More specifically, the Examiner stated that “the specification, while being enabling for a method of inhibiting  $\beta$ -catenin expression in vivo in selected organs of chicken embryos using a mRNA-cDNA hybrid duplex, does not reasonably provide enablement for a method of inhibiting

expression from any target gene, particularly any cancerous gene, liver or skin, in vivo in any organism using a mRNA-cDNA hybrid duplex and does not provide enablement for inhibiting expression of a target gene using a mRNA-cDNA duplex wherein the duplex is generated in a cell or organism using a mRNA-cDNA template.” See the Office Action, page 5, third paragraph.

Without acquiescence in the Examiner’s rejections and for the sole purpose of moving the prosecution of this application forward, Applicants have amended claims 32 and 69 by limiting the targeted gene to a  $\beta$ -cantenin gene in a cell in the liver or skin of a chicken embryo and deleting the limitation “used by the cell or organism as a template to generate small gene-silencing effectors.” Applicants thus respectfully submit that the rejections have been overcome and should be withdrawn.

### CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (310) 785-4600 to discuss the steps necessary for placing the application in condition for allowance.

Appl. No. 09/920,342  
Amdt. Dated May 27, 2009  
Reply to Office Action of January 27, 2009

Attorney Docket No. 89188.0022  
Customer No.: 26021

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,  
HOGAN & HARTSON L.L.P.

Date: May 27, 2009

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